

Application Number: 10/654,167

Dkt. No.: DT-024-US-01

REMARKS

Claims 1, 2, 4-6, 9, 11-12, 14, 17 and 19-25 are in the case.

Paragraphs [060] and [062] in the Specification have been amended to incorporate an inherent property (peak melting point) of the commercially available ethylene and methyl methacrylate copolymer that are disclosed at page 4, paragraph [021] of the specification and the examples. A copy of an inventor's Declaration with the Differential Scanning Calorimetry (DSC) test result sheets showing the incorporated property (peak melting point) from the Analytical Dept. of H.B. Fuller Company is submitted herewith as Exhibit A. No new matter is introduced by the amendment to the specification incorporating inherent property pursuant to MPEP 2163.07(a), "By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973)."

Claims 8, 10, 15 and 18 have been canceled. Claims 1 and 19 have been amended to incorporate an inherent property (peak melting point). Claim 11 has been amended. Claims 4-6 and 14 have been amended to depend upon claim 1 or claim 11. New claims 21-25 have been added. Support for the amendment to the claims and to the new claims can be found in the original disclosure, e.g., on page 3, paragraph [003], page 4, paragraph [021], page 5, paragraph [024], page 6, paragraph [028], page 14, paragraph [060] and page 16, paragraph [062], the examples, and the original claims as well as the inventor's Declaration with the Differential Scanning Calorimetry (DSC) test results.

Claims 19 and 20 have been withdrawn from consideration due to a restriction requirement, but would be rejoined upon the allowance of the elected product claims pursuant to MPEP 821.04.

I. Claim Rejection under 35 U.S.C. § 102 (b) over US 6,946, 528

Claims 1, 2, 4, 8-9, 11-12, 14 and 15 are rejected under 35 U.S.C. § 102(b) over U.S. Patent 6,946,528 to Domine et al. (hereafter "Domine").

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Domine discloses a hot melt adhesive composition including a tubular reactor copolymer of ethylene and an alkyl acrylate or alkyl methacrylate (Abstract). Domine discloses that the copolymers have a peak melting point, determined by DSC, of at least 100°C, at least 105°C or at least 110°C (col. 6, lines 29-34).

Independent claim 1 has been amended. The amended claim 1 is directed to a hot melt adhesive composition including an ethylene methyl methacrylate copolymer that has a peak melting point of no greater than about 67°C ± 6°C.

Domine does not disclose a hot melt adhesive composition that includes an ethylene methyl methacrylate copolymer having a peak melting point of no greater than about 67°C ± 6°C. Lacking at least one required element of claim 1, Domine does not and cannot anticipate claim 1. Claim 8 has been canceled. Claims 2, 4, and 9, each depending from claim 1, are also novel over Domine for the same reason delineated above.

Independent claim 11 has been amended. The amended claim 11 is directed to a hot melt adhesive composition that includes an autoclave reactor ethylene methyl methacrylate copolymer.

Domine does not disclose a hot melt adhesive composition that includes an autoclave reactor ethylene methyl methacrylate copolymer. Instead, Domine discloses tubular reactor copolymers of ethylene and alkyl acrylate or alkyl methacrylate. Domine discloses that ethylene and alkyl acrylate or alkyl methacrylate copolymers made in a tubular reactor show significantly higher peak melt temperatures than similar copolymers made in an autoclave reactor (Domine, col. 1, lines 56-59). Domine also discloses specifically that his tubular reactor copolymers can have a peak melting point at least 25°C, at least 35°C or at least 50°C greater than the peak melting temperature of a copolymer of the same chemical composition, such as those produced in autoclave reactors (Domine, col. 6, lines 34-39). Lacking at least one required element of claim 11, Domine does not and cannot anticipate claim 11. Claim 15 has been canceled. Claims 12 and 14, each depending from claim 11, are also novel over Domine for the same reason delineated above.

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Accordingly, the rejection of claims 1, 2, 4, 8-9, 11-12, 14 and 15 under 35 U.S.C. §102 (b) over Domine is unwarranted. Applicants respectfully requests that it be withdrawn.

II. Non-rejected Claims 5, 6 and 17

In addition to the reason delineated above, the non-rejected claims 5, 6 and 17 are novel over Domine because each of these claims includes an additional copolymer or a block copolymer, whereas the adhesive composition of Domine does not include any additional copolymer or block copolymer. At least for this reason, claims 5, 6, and 17 are patentable over Domine.

III. New claims 21-25

New independent claim 21 and dependent claims 22-25 are directed to a hot melt adhesive composition that includes, an ethylene methyl methacrylate copolymer, a tackifying resin, a wax, and an additional copolymer. The composition does not include a surfactant or a copolymer of ethylene and n-butyl acrylate. As stated in the above II, Domine does not disclose an adhesive composition that includes an additional copolymer other than the copolymers of ethylene and alkyl acrylate or alkyl methacrylate. As least for this reason, new claims 21-25 are patentable over Domine.

In view of all the forgoing, Applicants submit that the claims now pending in the application are in condition for allowance and action in accordance therewith is respectfully requested. In the event that claims are not allowed, the Examiner is invited to telephone the undersigned should a teleconference interview facilitate the prosecution of the application to allowance.

Respectfully submitted,

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